

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No.: 10/023,241 Confirmation No.: 3705
Applicant: Philip M. Ginsberg
Title: AUTOMATED COMMISSION PROCESSING
Filed: December 17, 2001
Art Unit: 3693
Examiner: Harish T. Dass

Atty. Docket: 01-1016
Customer No. 63710

REQUEST FOR COMPLETION OF OFFICE ACTION PURSUANT TO MPEP § 710.06

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Commissioner for Patents
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Pursuant to MPEP § 710.06, Applicant calls to the attention of the Office to errors in the Office's paper of June 5, 2007, and requests (a) that the Office reissue the paper in corrected and completed form, and (b) reset the period for reply to one month from the date of the reissued Office paper. Note that this paper is **not** a Rule 111 or 116 reply. Rather, this paper requests a replacement Action and resetting of the period for reply. An Advisory Action would be non-responsive and procedurally inappropriate.

MPEP § 710.06 was recently amended to read as follows (underline added):

710.06 Situations When Reply Period Is Reset or Restarted

Where ... an Office action contains some other error that affects applicant's ability to reply to the Office action ... If the error is brought to the attention of the Office within the period for reply set in the Office action but more than 1 month after the date of the Office action, the Office will set a new period for reply, if requested to do so by the applicant, to substantially equal the time remaining in the reply period. ... The new period for reply must be at least 1 month and would run from the date the error is corrected. ...

A supplementary action after a rejection explaining the references more explicitly or giving the reasons more fully, even though no further references are cited, establishes a new date from which the statutory period runs.

Kindly provide a corrected Action that corrects the following errors, or allows the relevant claims:

1. Paragraph 1 of the Action begins with MPEP form paragraph 7.05.01, but the body of paragraph 1 bears no perceptible relationship to the instructions given in MPEP § 706.03(a) and § 2106. The Action does not even mention any of the relevant legal inquiries, “an abstract idea, natural phenomenon, or law of nature,” “practical application,” “physical transformation,” “preemption,” and the like.

Because the Office Action fails to follow any coherent set of instructions from the MPEP or any written law, it is impossible to even identify the Examiner’s concern, let alone reply.

The Examiner’s attention is drawn to the following box from the flowchart in MPEP § 2106. If any issue is thought to arise under § 2106, Applicant requests a step-by-step showing of each element of a *prima facie* case be “established on the record” as required by the MPEP.

▼

DETERMINE WHETHER THE CLAIMED INVENTION COMPLIES WITH THE SUBJECT MATTER ELIGIBILITY REQUIREMENT OF 35 U.S.C. 101

- Does the Claimed Invention Fall Within an Enumerated Statutory Category?
- Does the Claimed Invention Fall With a 35 U.S.C. 101 Judicial Exception – Law of Nature, Natural Phenomena or Abstract Idea?
- Does the Claimed Invention Cover a 35 U.S.C. 101 Judicial Exception, or a Practical Application of a 35 U.S.C. 101 Judicial Exception?
 - Practical Application by Physical Transformation?
 - Practical Application That Produces a Useful (35 U.S.C. 35 U.S.C. 101 utility), Tangible, and Concrete Result?
- Does the Claimed Invention Preempt a 35 U.S.C. 101 Judicial Exception (Abstract Idea, Law of Nature, or Natural Phenomenon)?
- Establish on the Record a *Prima Facie* Case

The lack of conformity between the Action and MPEP § 2106 is an error that affects Applicant’s ability to reply. The Action should be corrected and reissued with a new reply period. If any § 101 issue is thought to apply, it should be explained in the manner instructed by the Director in the MPEP.

2. Paragraph 2 of the Action begins with form paragraph 7.31.02, directed to § 112 ¶ 1 “enablement.” However, the body of paragraph 2 of the Action is not completed in the manner instructed by the Director in MPEP § 706.03(c) and § 2164-2164.06. For example, the Action never uses the term “undue experimentation,” and contains no consideration of the factors required by MPEP § 2164.01(a). The Action is dead silent on “a reasonable basis to question the enablement provided for the claimed invention,” in violation of MPEP § 2164.04.

Paragraph 2 observes that the claim is broad, because it does not teach “how to” implement the invention in hardware or software. This represents one of two errors. It cannot be relevant to § 112 ¶ 2, because “breadth is not indefiniteness.” MPEP § 2173.04. It cannot be relevant under § 112 ¶ 1, because teaching “how to” is a job is for the specification (in conjunction with the knowledge of one of ordinary skill), not for the claims – there is no requirement that the claims teach “how to.” MPEP § 2174 warns that the requirements of § 112 ¶ 1 and ¶ 2 must not be confused.

The failure to state a recognizable legal issue in the manner required by the MPEP is an error that affects Applicant’s ability to reply. If any issue under any one statutory provision (not a mix-and-match of several provisions) is thought to apply, a corrected Office Action should be issued that sets forth a *prima facie* case addressing the points required by the MPEP.

3. Paragraph 3 of the Action overlooks the instruction of MPEP § 2173.05(e), “Obviously, however, the failure to provide explicit antecedent basis … does not always render a claim indefinite,” and “Inherent components of elements recited have antecedent basis in the recitation of the components themselves.” Nowhere does the MPEP authorize mere technical lack of antecedent basis as a basis of rejection, without further explanation.

The Action also fails to consider the language of the claims.

- Claims 13, 23, 25 and 37 do not recite “the group” in isolation, they recite “the group consisting of” using the precise language that is recommended by the PTO (MPEP § 2173.05(h)). Why is use of the PTO’s own recommended language indefinite?
- Why is the use of the term “a trade” in line 7 of claim 13 insufficient antecedent basis for “the trade” in line 8? Similarly for claims 23, 25 and 37?
- Claims 13, 23 and 25 do not recite “the time” in isolation, they recite “the time of the trade.” Why is this indefinite? Why is “the time” not an “inherent component” of “the trade?”
- Claim 23 does not recite “the purchase” in isolation, it recites “transacting the purchase and sale of select items.” Why is this indefinite?

The failure to consider the claim language as a whole and to provide an explanation consistent with MPEP § 2173.05(e) is an error that affects Applicant’s ability to reply. The Action should be reissued.

4. 37 C.F.R. § 1.104 37 C.F.R. § 1.104(c)(2) reads as follows (underline added):

§ 1.104 Nature of examination.

(c) Rejection of claims.

(2) In rejecting claims for want of novelty or for obviousness … When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

That is, in situations where the reference discloses anything more than or in addition to the invention claimed, as here, an Office Action must do two things: (i) "designate" portions as nearly as practicable, and (ii) "clearly explain" the pertinence.

For the claim language "a commission payable by a customer ... based at least in part on ... the time of the trade, day of the trade, location of a trade, and the customer trading location" the Action does neither. The Action designates 2½ columns, not a designation "as nearly as practicable." If there is any portion of these 2½ columns that relates to the words "based on" in the claim, it is not "apparent" without a "clear explanation" of "pertinence." This failure to comply with Rule 1.104(c)(2) is an "error that affects applicant's ability to reply" and requires correction and resetting the time for reply.

5. This "based on" language was discussed in Applicant's reply of March 14, 2007, yet this language is apparently overlooked again in the Action of June 5, 2007. This failure to "answer all material traversed" violates MPEP § 707.07(f), and is an "error that affects applicant's ability to reply" that requires correction and resetting the time for reply.
6. Applicant's paper of March 14, 2007 made a request under 37 C.F.R. § 1.104(d)(2) for substantial evidence to support "motivation to combine," and a showing of "motivation to combine" to reach the particular invention claimed, not merely to combine two references in gross. The Action of June 2007 gives an explanation for "motivation to combine" that appears to be based on nothing more than the examiner's personal opinion formed in hindsight, and is no more than a showing that some part of one reference can be combined with some part of the other, but the showing is not specific to this invention. Applicant again requests "substantial evidence," and a showing focused on this invention. This failure to comply with Rule 1.104(d)(2) and failure to "answer all material traversed" is an "error that affects applicant's ability to reply" that requires correction and resetting the time for reply."
7. The MPEP notes that no obviousness rejection exists unless an Office Action makes a showing of "reasonable expectation of success." MPEP § 2143.02; *KSR International Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1742, 82 USPQ2d 1385, 1397 (2007) ("anticipated success" is a crucial aspect of obviousness). Omission of consideration of "reasonable expectation of success" is an error that affects an applicant's ability to reply – no "reply" is possible to an unstated position.

Applicant requests a corrected Office Action, and if no such Action can be prepared, that the application be passed to issue in due course. The Examiner is urged to telephone Applicant's undersigned counsel at the number noted below if it will advance the prosecution of this

application, or with any suggestion to resolve any condition that would impede allowance. Kindly charge any additional fee, or credit any surplus, to Deposit Account No. 50-3938, Order No. 01-1016.

Respectfully submitted,

Dated: September 4, 2007

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